



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
* Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/091,805	12/10/1998	TOSHIYUKI NAKATA	MATS:006	5347

7590 04/23/2003
ROSSI & ASSOCIATES
PO BOX 826
ASHBURN, VA 20146-0826

EXAMINER

NGUYEN, TUYEN T

ART UNIT	PAPER NUMBER
----------	--------------

2832

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/091,805

Applicant(s)
Nakata et al.

Examiner
Tuyen T. Nguyen

Art Unit
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/11/03 and 4/2/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 6, 9, 12, 14, 17-26, 28, 30, 32-37, 40, 41, and 44-52 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 6, 9, 12, 14, 21-26, 28, 30, and 32-37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20, 40, and 41 is/are allowed.
- 6) ☒ Claim(s) 17-19 and 44-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2832

DETAILED ACTION

Election/Restriction

1. Claim 30 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant elected embodiment one [figures 1-9] in paper #10, filed 02/12/2001. Claim 30 is directed toward figure 10 [see element 52 of insulating sheet 33].

Applicant states that claims 2, 6, 9, 12, 14, 21, 25, 28 and 32-37 were canceled by the amendment filed in accordance with PCT Rule 19(1) but there is no such paper in the application. Applicant should provide an amendment canceling these claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17-19 and 44-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, the term “generally” is a relative term. There is no antecedent basis for “the plane of the yoke.” Applicant should clarify what is intended by “generally along the plane of the yoke associated with said at least one of the notches and confined within the notch.”

Art Unit: 2832

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 17-19, 44 and 46-51 are rejected under 35 U.S.C. 102(a) as being anticipated by Takahashi et al. [JP 7-320961].

Takahashi et al. discloses a surface mounting device [figures 1-2] comprising:

- a core structure including first and second E-shaped core elements [4, 5], each comprising a notch formed therein; wherein the center leg of the core structure having a cross section shaped in circle

- a magnetic gap provided between the center leg of the core structure;

- a circular coreless coil structure [10, 11, 20] including a plate-type wire comprising at least one of a flat type wire and a foil type wire, wherein the coreless coil disposed the center leg of the core structure and separated by an insulating layer [30];

- an insulating sheet [7] provided between the coreless coil and the core structure; and

- inside and outside plate-type terminals [13, 14, 23, 24, 38, 40].

wherein the inside terminal led outside the magnetic core structure through one of the notch of the magnetic core structure, *generally along the plane of the yoke associated with the at least one of the notches* and confined within the notch.

Art Unit: 2832

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. in view of Saitoh et al. [US 5,204,653].

Takahashi et al. discloses the instant claimed invention except for the core being formed of manganese ferrite.

Saitoh et al. discloses a core structure for an induction device with the core being formed of manganese ferrite material [column 8, lines 59-68].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use manganese ferrite for the core structure of Takahashi et al., as suggested by Saitoh et al., for the purpose of improving magnetic permeability.

Allowable Subject Matter

8. Claims 20 and 40-41 are allowed.

Response to Arguments

9. Applicant's arguments with respect to claims 17, 20, 40-41 and 44-52 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2832

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Elvin Enad, can be reached at (703) 308-7619. The fax number for this Group are (703) 308-7722 and (703) 308-7724.

Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

TTN *TTN*

April 21, 2003

Tuyen T. Nguyen